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OFFICE OF PETITIONS

In re Application of :
Joseph Kuriacose, Ansley Jessup : ON PETITION
Vincent Dureau and Alain Delpuch :
Application No. 09/672,523 :
Filed: September 27, 2000 :
Atty Docket No. 2050.001US3 :

This reissue application is before the Office of Patent Legal Administration, for consideration of the "RENEWED PETITION UNDER 37 C.F.R. §1.183" filed July 2, 2012.

In this instance, waiver is sought with respect to the requirement based on 37 CFR §§ 1.67, 1.172 and 1.175 that a supplemental declaration be executed by the named inventors in a broadening reissue application.

The renewed petition is **GRANTED**.

BACKGROUND

1. The present application for reissue of patent No. 5,819,034 (issued October 6, 1998) was filed on September 27, 2000. It was filed by the assignee as a broadening reissue application.
2. On November 8, 2000, the Office mailed a Notice to File Missing Parts of Reissue Application, requesting a signed oath or declaration, a late surcharge, and a written consent of assignee. A reply was filed on December 19, 2000; however, it did not include a written consent of assignee and did not

include a § 3.73(b) statement. On May 29, 2008, a written consent of assignee and a § 3.73(b) statement were filed.

3. On November 18, 2009, a non-final Office action was mailed, advising applicants that the Substitute reissue declaration filed March 30, 2009 is defective because:

the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. Specifically, the filed substitute declaration was said to not identify the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective.

4. On February 20, 2012, applicants filed an initial petition seeking permission to file the supplemental reissue declaration without the signature of joint inventor Ansley Wayne Jessup.
5. By decision mailed May 2, 2012, the petition was dismissed for failure to submit adequate proof of the non-signing inventor's refusal to execute the supplemental reissue declaration. The original petition includes a showing that the substitute reissue declaration was presented by email and federal express delivery to inventor Jessup. The original petition does not include an express refusal by the inventor. Rather, in the original petition, applicants seek to have the Office infer refusal by conduct. In the February 25, 2012 decision on the original petition, petitioner was informed that such an inference cannot be made where, as here, it is not shown that the inventor was presented with all of the application papers.

DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR § 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1) requires that:

For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or

declaration stating that every such error arose without any deceptive intention on the part of the applicant.

37 CFR 1.175(b)(1), taken in conjunction with § 1.172, requires a supplemental declaration to be signed by the inventor. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventor.

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by all of the inventors.

While 37 CFR 1.47(a) is not directly applicable to the current set of facts, it does provide an analogous analysis as to the required showing to rectify situations involving a non-signing joint inventor as to a declaration. As such a 37 CFR 1.47(a) analysis was, and is being, applied, to the extent applicable, to determine whether justice requires the waiver of the rules in this situation.

The instant renewed petition, via the supporting documentation, provides an appropriate and sufficient showing that joint inventor Jessup has refused to sign the supplemental declaration. On renewed petition, it is shown that inventor Jessup signed for the Federal Express delivery of the application papers on June 7, 2012. However, he has not responded to the request to sign the supplemental reissue declaration. Such conduct is sufficient to constitute a refusal.

Accordingly, the rules are hereby waived to the extent that the "Supplemental Reissue Application Declaration" submitted on February 20, 2012 will be accepted as though it was signed by all of the inventors, as required by 37 CFR 1.175(b)(1) taken in conjunction with §1.172.

CONCLUSION

1. The petition under 37 CFR 1.183 is granted to waive the rules to the extent stated in this decision.

2. The provisions of 37 CFR §§ 1.67, 1.172 and 1.175 are hereby waived to the extent that the February 20, 2012 "Supplemental Reissue Application Declaration" submitted on petition will be accepted as though it was signed by all of the inventors.
3. Jurisdiction over the present application is being forwarded to Technology Center 3625 for further examination.
4. Any questions regarding this decision should be directed to Senior Petitions Attorney, Nancy Johnson at (571) 272-3219.

/Kenneth M. Schor/

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Senior Legal Advisor
Office of Patent Legal Administration

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